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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,559	09/05/2003	Cheryl M. Waldron-Floyde	884.103US3	8182
21186	7590	12/21/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			JOHNSON, JONATHAN J	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,559

Applicant(s)

WALDRON-FLOYDE ET AL.

Examiner

Jonathan Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Karavakis (5,663,106). Karavakis teaches a body having a first and second opposing surfaces (Figure 7, Item 46) and a number of depressions formed in the first surface so as to receive pins of a floating pin field when placed on a floating pin field during connection of the floating pin field to a PCB, wherein each depression is configured to receive only one of the pins and to hold the pins in substantially vertical alignment with respect to the first surface (Figure 7, Item 46). It is the examiner's position that the floating pins assembly and the circuit board are process limitations that hold little patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,743,009 (Matsui) in view of Applicant's Admitted Prior Art (AAPA). Matsui teaches a jig having depressions to accommodate a chain of contact pin parts that pass throughout the center and outer regions such that the jig holds the pins in substantially vertical alignment with respect to the surface (see Figure 12, Item 216); depressions are formed in rows along the perimeter of the body (Figure 12, Item 216); use of a material that exhibits substantially no warping during reflow (Column 6, Lines 40-45); depressions at the surface are greater than the diameter of the inside of the body (Figure 12, Item 216); the plurality of depressions having angles less than 90 degrees (Figure 13, item 216); a field carrier coupled to the plurality of pins (figure 12, item 211); wherein the alignment weight further includes a plurality of passages that pass through a thickness of the alignment weight (figure 12, item 216). AAPA teaches the use of pins without the use of a linking member to form chains (Page 1, Lines 15-30) and pins extending throughout the workpiece (see Figure 12, Items 216 and Figure 1, Item 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the jig of Matsui to utilize substantially circular holes in order to accommodate pressing against the singular pins in order to ensure the pin parts are connected to the circuit board (see Matsui Column 8, Lines 1-7 and AAPA paragraphs 3-4).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,648,204. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US 6,648,204 encompass the subject matter of the instant application.

Response to Arguments

Applicants claim to have submitted a terminal disclaimer, but no such paper has been received.

Applicants argue the dimples of Karavakis are not able to function to provide "substantially vertical alignment." While this may be true, the examiner would like to point out that applicant's statement is merely an assertion. Applicant is reminded that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Applicant is invited to submit an affidavit or declaration showing that Karavakis is not able to provide "substantially vertical alignment." That is, why would the pins, as applicants suggest, come out of alignment merely because the shield is deformable? Why wouldn't the shield merely deform around the pins to further hold the pins in place?

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Applicants next argue that claims 4 and 13 are not met by Karavakis. The examiner notes that Karavakis was used to reject only claims 1 and 11.

Applicants next argue that Matsui's groove does not teach the claim 1 limitation of "depressions are configured to receive only one of the pins." The examiner agrees. This argument, however, amounts to arguing against the references individually. The examiner would like to note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue that neither AAPA or Matsui not teach "substantially circular holes." The examiner agrees. Applicant goes on to argue that because of this, the 103 rejection must be withdrawn. The examiner disagrees. It is the examiner's position that the combined teachings of Matsui and AAPA provide motivation for this limitation. Matsui teaches the desirability of using a jig to press against a contact pin connection (see Matsui, col. 8, ll. 40-45), where the jig conforms to the contact pin connection (see Matsui figure 12, item 215 and 201). In particular, Matsui teaches the contact pin connection is arranged in the shape of a line (see Matsui, figure 12, ll.) and where the jig also has a groove in the shape of a line (see Matsui, figure 12, item 215) so that the jig conforms to the contact pin connection. AAPA teaches a contact pin connection in the shape of a dot at the tip of the pin. As stated in the previous office action, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the jig of Matsui to utilize substantially circular holes in order to accommodate pressing against the singular pins in order to ensure the pin parts are connected to the circuit board (see Matsui Column 8, Lines 1-7 and AAPA paragraphs 3-4).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

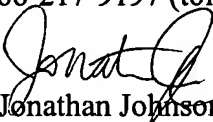
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Johnson whose telephone number is 571-272-1177. The examiner can normally be reached on M-Th 7:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jonathan Johnson
Primary Examiner
Art Unit 1725

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